



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/781,619

02/20/2004

Timothy M. Corcoran

149887

4142

38598

7590

08/25/2009

ANDREWS KURTH LLP

1350 I STREET, N.W.

SUITE 1100

WASHINGTON, DC 20005

EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

08/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/781,619	Applicant(s) CORCORAN ET AL.	
	Examiner CRISTINA SHERR	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to Applicant' Amendment filed April 8, 2009. Claims 1, 2, 8, and 21-22 are currently pending in this case. Claims 3-4, 6-7 and 9-20 had been previously canceled. Claims 1, 2, and 8 are currently amended. Claims 21 and 22 have been newly added.

Response to Arguments

2. Applicant's arguments filed April 8, 2009 have been fully considered but they are not persuasive.

3. Applicant argues, regarding claims 1 and 8, as currently amended, that nothing in the cited prior art teaches, discloses or suggests, "wherein the processor section further includes a routine for checking compliance with the proposed rules."

4. Examiner respectfully disagrees. Kennedy discloses (at col 4 ln 49-55, col 5 ln 60-67) "validation" or "handshake protocol" which is equivalent to checking compliance with a set of rules. Also col 10 ln 10-15 discloses checking for "reporting events" which are cases of rules being followed or not.

5. Note also, that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

6. In this case, in claim 1, we find that a system is an apparatus. Tracking transportation of goods rather than tracking anything else, and using rules

Art Unit: 3685

acknowledged by a government agency rather than anyone else, refer to what the apparatus does rather than what it is. Further, Kennedy does refer to similar rules, such as the rules utilized to designate a “reporting event” (e.g. fig. 4/116, and corresponding text). Such features, therefore, do not serve to further distinguish the claims from the prior art.

7. Also, with respect to the two “wherein” clauses in claims 1 and 22, (“wherein one or more rules ...’ and “wherein the processor section . . .”, note that a whereby clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. (*Texas Instruments Inc. v. International Trade Commission* 26, USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (CAFC 2001)

8. Applicant argues, regarding claim 2, that nothing in the cited prior art discloses, teaches or suggests, “an interface to a mutual benefit association including commercial entities and government agencies, wherein the commercial entities propose the one or more rules to be acknowledged by the government agency, and wherein the commercial entities and the government agencies use the interface to provide information to the GCCIC system and receive information and products from the GCCIC system.”

9. Examiner respectfully disagrees.

10. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of

Art Unit: 3685

structure rather than function alone. MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

11. In this case, in claim 2, we find that a system is an apparatus. Using rules acknowledged by a government agency rather than anyone else, refer to what the apparatus does rather than what it is. Such features, therefore, do not serve to further distinguish the claims from the prior art.

12. Note also that Kennedy, at col 12 ln 5-20, discloses wherein the individual messaging unit, or the user unit receives messages regarding status, updating reporting limits, etc., via voice channel. This is an interface, which is in contact with the rules to be observed, and which reports updates or changes to the rules. As above, whether the rules are acknowledged or proposed by a government agency rather than anyone else, refer to what the apparatus does rather than what it is. Further, Kennedy does refer to similar rules, such as the rules utilized to designate a “reporting event” (e.g. fig. 4/116, and corresponding text). Such features, therefore, do not serve to further distinguish the claims from the prior art.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. If the broadest reasonable

Art Unit: 3685

interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. MPEP §2105.

15. In this case, claims 21 and 22 recite rules being acknowledged by a government agency. Under the broadest reasonable interpretation, this feature is being performed by a person -- a government employee -- somewhere. For this reason, newly added claims 21 and 22 are rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1, 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, II et al (US 6,240,295).

18. Kennedy discloses an information clearinghouse ("clearinghouse" fig 1-22), comprising:

a system having a central information repository ("platform" col 4 ln 25-40) wherein information related to transactions is processed and stored, the repository, comprising:

a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55),

Art Unit: 3685

a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and

a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55, col 7 ln 4-45, col 7 ln 65- col 8 ln 16, where “reporting events” are governed by certain rules, such as change in location or temperature of the cargo, and these rules are equivalent to government agency rules of the instant application);

wherein the processor section further includes a routine for checking compliance with the proposed rules. (at col 4 ln 49-55, col 5 ln 60-67) “validation” or “handshake protocol” which is equivalent to checking compliance with a set of rules. Also col 10 ln 10-15 discloses checking for “reporting events” which are cases of rules being followed or not.)

19. Note that Kennedy discloses a clearinghouse for information regarding transactions such that transactions are tracked by means of the information relating to them. Kennedy discloses an information clearinghouse (“clearinghouse” fig 1-22), comprising:

a system having a central information repository (“platform” col 4 ln 25-40) wherein information related to various transactions (in the case of the instant application it is transactions with respect to transportation of goods, in Kennedy the transactions have to do with cell phone usage, nevertheless they are both tracking information regarding transactions) wherein information is processed and stored, the repository, comprising:

Art Unit: 3685

a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55),

a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and

a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55). See also, col 7 ln 4-45, col 7 ln 65- col 8 ln 16, where “reporting events” are governed by certain rules, such as change in location or temperature of the cargo, and these rules are equivalent to government agency rules of the instant application

20. It is obvious to one of ordinary skill in the art that a clearinghouse tracks transactions via information thereon, what type of transaction is moot, further it is obvious to use such a clearinghouse to track any type of transactions, whether related to transportation of goods or any other type of transaction. KSR forecloses Appellant’s argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

21. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the clearinghouse of Kennedy, like most clearinghouses, has the capability of tracking transactions, whether it happens that such transaction have to do with transportation of good or not, does not further distinguish the claim from the prior art.

Art Unit: 3685

22. Regarding claim 8 –

23. Kennedy discloses a method for operation of an Information Clearinghouse (“clearinghouse” fig 1-22), comprising: providing a clearinghouse system including a central information repository (“platform” col 4 ln 25-40); providing a set of rules for operating the clearinghouse system(e.g. col 4 ln 40-55); and monitoring compliance with the adopted rules. (e.g. col 7 ln 4-18).

24. As above, note that Kennedy discloses a clearinghouse for information regarding transactions such that transactions are tracked by means of the information relating to them. Kennedy discloses an information clearinghouse (“clearinghouse” fig 1-22), comprising: a system having a central information repository (“platform” col 4 ln 25-40) wherein information related to various transactions (in the case of the instant application it is transactions with respect to transportation of goods, in Kennedy the transactions have to do with cell phone usage, nevertheless they are both tracking information regarding transactions) wherein information is processed and stored, the repository, comprising: a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55), a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55, col 7 ln 4-45, col 7 ln 65- col 8 ln 16, where “reporting events” are governed by certain rules, such as change in location or temperature of the cargo, and these rules are equivalent to government agency rules of the instant application). It is obvious to one of ordinary skill in the art that a

Art Unit: 3685

clearinghouse tracks transactions via information thereon, what type of transaction is moot, further it is obvious to use such a clearinghouse to track any type of transactions, whether related to transportation of goods or any other type of transaction. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

25. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. *MPEP* 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the clearinghouse of Kennedy, like most clearinghouses, has the capability of tracking transactions, whether it happens that such transaction have to do with transportation of good or not, does not further distinguish the claim from the prior art.

26. Regarding claim 21 –

27. Kennedy discloses wherein the processor section further includes a routine for checking compliance with the rules. (at col 4 ln 49-55, col 5 ln 60-67)

28. Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of “Farmer’s Mutual Benefit Association”.

29. Regarding claim 2 –

30. Kennedy discloses as discussed above. Specifically, Kennedy, at col 12 ln 5-20, discloses wherein the individual messaging unit, or the user unit receives messages regarding status, updating reporting limits, etc., via voice channel. This is an interface,

Art Unit: 3685

which is in contact with the rules to be observed, and which reports updates or changes to the rules.

31. Mutual benefit associations are old and well-known. See, e.g. "Farmer's Mutual Benefit Association" (http://en.wikipedia.org/wiki/Farmers'_Mutual_Benefit_Association). Such associations include different entities which may or include both private and public sector entities, and they propose or make up rules to be followed by all of them. See also <http://delcode.delaware.gov/title18/c055/index.shtml>.

32. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Further, Applicants are merely taking known elements and combining them to obtain a predictable result.

33. Regarding claim 22 –

34. Kennedy discloses as discussed above. Specifically, Kennedy, at col 12 ln 5-20, discloses wherein the individual messaging unit, or the user unit receives messages regarding status, updating reporting limits, etc., via voice channel. This is an interface, which is in contact with the rules to be observed, and which reports updates or changes to the rules.

35. Mutual benefit associations are old and well-known. See, e.g. "Farmer's Mutual Benefit Association" (http://en.wikipedia.org/wiki/Farmers'_Mutual_Benefit_Association). Such associations include different entities which may or include both private and public sector entities, and they propose or make up rules to be followed by all of them. See also <http://delcode.delaware.gov/title18/c055/index.shtml>.

Art Unit: 3685

36. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Further, Applicants are merely taking known elements and combining them to obtain a predictable result.

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

38. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

Art Unit: 3685

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621